APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/921,298	KUTTER, PHILIPP W.
	Examiner	**Art Unit**	
	Andre R. Fowlkes	2192	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _18 March 2005_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-21_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-21_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed 3/18/05.

Claim Rejections - 35 USC § 112

2.   The rejection to claims 1-10 is rejected under 35 U.S.C. 112, second paragraph,

is withdrawn, in view of applicant's amendment.

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 6 does not clearly define the element or describe the

algorithm and actions performed by the code in the claim. Appropriate correction is

required.

Claim Rejections - 35 USC § 101

5.   The rejection to claims 1-10 under 35 U.S.C. 101 is withdrawn, in view of

applicant's amendment.

Drawings

6.   The objection to the drawings is withdrawn, in view of applicant's amendment.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8.   Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by De Boor

et al. (De Boor) U.S. Patent No. 6,173,316.

As per claim 1, De Boor discloses a **method for the direct execution of an**

XML-document in a data processing system, (col. 3:58-67, "providing a wireless

communication device with an MMI (i.e. browser) that is based on a markup language

(i.e. XML). A markup language is a computer programming language that allows the

content of a page or a screen display to be defined by the inclusion of predefined

symbols in the content itself indicating the logical components of the content,

instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content", and col. 9:45-51, "The present invention is not limited to HTML, but also operates with, and may extend any other markup language, such as SGML, or XML"), **comprising:**

- defining the local behavior and process for each element of the XML-document (col. 3:59-66, "A markup language (i.e. XML) is a computer programming language that allows the content of a page or a screen display (i.e. local behavior and process) to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen"),

- integrating executable instructions with at least one XML-document or a document type definition (DTD) (col. 3:58-60, "providing a wireless communication device with an MMI (i.e. browser) that is based on a markup language (i.e. XML).", and this process is essentially the integration of the executable instructions with the XML document),

- storing intermediate states of the execution process in a memory of the data processing system by dynamically creating and redefining attributes of elements of the XML document (col. 62:9-10, "(intermediate states of the process are stored and) replacing the tag with the second markup language page to form a combined markup language page (i.e. the elements are redefined)").

As per claim 2, the rejection of claim 1 is incorporated, and further De Boor discloses that:

- **integrating executable instructions by defining for each XML-element definition and its instances an action made up of executable actions, and actions which are references to either the action defined for one of the components of the element or to an action defined for any other element of the XML document** (col. 3:58-67, "providing a wireless communication device with an MMI that is based on a markup language (i.e. executable instructions integrated with XML documents). A markup language is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content"),

- **executing an XML-document by executing the action defined for the root of the XML document** (col. 3:59-66, "A markup language (i.e. xml document) is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content").

As per claim 3, the rejection of claim 1 is incorporated, and further De Boor

discloses that **defining a composition of the action for at least one XML-element**

definition or instance by graphical flow charts (col. 7:36-38, "a flowchart of the

operation of the HTMLp content handler in processing a string input associated with a

user interface gadget", and col. 9:49-51, "The present invention is not limited to HTML,

but also operates with, and may extend any other markup language, such as SGML, or

XML").

As per claim 4, the rejection of claim 1 is incorporated, and further De Boor

discloses **defining the composition of the action for at least one XML-element**

definition or instance in textual form (col. 3:59-66, "A markup language (i.e. xml

document) is a computer programming language that allows the content of a page or a

screen display to be defined by the inclusion of predefined symbols in the content itself

indicating the logical components of the content, instruction for the layout of the content

on the page or screen (i.e. composition of the action), or other data which can be

interpreted by some automatic system responsible for displaying, manipulating or

modifying the content").

As per claim 5, the rejection of claim 1 is incorporated, and further De Boor

discloses:

- **representing system states** in terms of n-dimensional data cubes (col. 23:46-47, "determine the initial state of a form in a page", and one can store system states well known formats such as in data cubes or n-dimensional arrays),

- **providing an open interface by making the** state information **readable and writeable for other programming and database systems** (col. 23:42-47, "There are a number of extensions of HTML in the present invention that allow pages to be designed using a standard HTML editor, using arguments passed (through an open interface) by C code to complete form entry fields, or specifying data to be fetched on the fly from the device to determine the initial state of a form in a page"),

- **making data structures and functionalities of other programming and database systems accessible using executable instructions** (col. 23:42-47, "There are a number of extensions of HTML in the present invention that allow pages to be designed using a standard HTML editor, using arguments passed (using executable instructions) by C code to complete form entry fields, or specifying data to be fetched on the fly from the device to determine the initial state of a form in a page").

As per claim 6, the rejection of claim 1 is incorporated, and further De Boor discloses **modules stored in the memory of the data processing system that define a process for each element, where the modules are valid with respect to** a specific **DTD, which is also stored in a memory of the data processing system** (col. 3:59-66, "A markup language (i.e. XML) is a computer programming language that allows the content of a page or a screen display (i.e. local behavior and process) to be defined by

the inclusion of predefined symbols in the content itself indicating the logical

components of the content, instructions for the layout of the content on the page or

screen", and validating modules with respect DTDs is a well known practice used with

XML).

As per claim 7, the rejection of any one of the preceding claims is incorporated,

and further De Boor discloses a **system for use with the method according to one of**

the preceding claims, (col. 59:35-68:66, "The markup language based man-machine

interface", as disclosed in the claims)**, comprising:**

- a server providing services to at least one client by executing at least

parts of a XML-document according to a XML-robot specification sent from the

client to the server or a server providing services to at least one client by sending

a XML-robot specification and a XML-document to the client, such that said

service is provided by executing of at least part of the sent document on the

client according to the sent XML-robot specification (col. 9:49-51, "providing a

wireless communication device with an MMI (i.e. browser) that is based on a markup

language (i.e. XML). A markup language is a computer programming language that

allows the content of a page or a screen display to be defined by the inclusion of

predefined symbols in the content itself indicating the logical components of the content,

instructions for the layout of the content on the page or screen, or other data which can

be interpreted by some automatic system responsible for displaying, manipulating or

modifying the content", and (below fig 14 and multi part forms) col. 30:14-22, "the data

from each form (i.e. executable xml document) to be transmitted to the server as part of

the URL that fetches the next form (i.e. executable xml document). The server then

takes the data passed in the URL and returns a page that must be generated on-the-fly

with the passed-in data from the previous forms included as "hidden" type input

elements in the form in the returned page").

As per claim 8-10, this is an apparatus version of the claimed method discussed

above, in claim 7, wherein all claimed limitations have also been addressed and/or cited

as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claim 11, this is an apparatus version of the claimed method discussed

above, in claim 7, wherein all claimed limitations have also been addressed and/or cited

as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claim 12, this is another method version of the claimed method discussed

above, in claims 3 and 5, wherein all claimed limitations have also been addressed

and/or cited as set forth above. For example, see De Boor, col. 7:36-23:47.

As per claim 13, this is a computer readable medium/product version of the

claimed method discussed above, in claims 3 and 5, wherein all claimed limitations

have also been addressed and/or cited as set forth above. Additionally, such a product

is deemed to be inherent in the system, otherwise, it would be inoperative.

As per claim 14, this is a computer readable medium/product version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. Additionally, such a product is deemed to be inherent in the system, otherwise, it would be inoperative.

As per claim 15, this is a system version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 16, this is a system version of the claimed method discussed above, in claim 2, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:58-66.

As per claim 17, this is a system version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 18, this is a system version of the claimed method discussed above, in claim 7, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claims 19 and 20, this is another method version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 21, this is another method version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:58-67, col. 9:45-51 and col. 62:9-10.

Response to Arguments

9.   Applicants arguments have been considered but they are not persuasive.

In the remarks, the applicant has argued substantially that:

1)   The Examiner incorrectly states that claim 7 is dependent upon claim 1, at p. 11:9-10 and 11:20-21.

Examiner's response:

1)   The preamble of claim 7 states: "a system for use with the method according to one of the preceding claims". This language indicates that claim 7 is dependant on any one of the previous claims, including claim 1.

In the remarks, the applicant has argued substantially that:

2)   DeBoor does not disclose a method including at least storing intermediate states

of the execution process in an XML document of a memory of the data processing

system by dynamically creating and redefining attributes of elements and that the

intermediate states stored applicant's invention are different from the intermediate

states stored by DeBoor, at p. 12:15-13:2.

Examiner's response:

2)   DeBoor does disclose storing intermediate states of the execution process in an

XML document of a memory of the data processing system by dynamically creating and

redefining attributes of elements, at col. 62:9-10.

       In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., the differences between the intermediate states stored by applicant's invention and

the intermediate states stored by DeBoor) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

In the remarks, the applicant has argued substantially that:

3)   DeBoor does not disclose sending an XML document that is executed according

to an XML robot specification, at p. 13:25-26.

Examiner's response:

3)   The examiner disagrees with applicant's characterization of the applied art.

DeBoor does disclose sending an XML document that is executed according to an XML

robot specification, at col. 9:39-30-22, "the data from each form (i.e. executable xml

document) to be transmitted to the server as part of the URL that fetches the next form

(i.e. executable xml document). The server then takes the data passed in the URL and

returns a page that must be generated on-the-fly with the passed-in data from the

previous forms included as "hidden" type input elements in the form in the returned

page".

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andre R. Fowlkes whose telephone number is (571)

272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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ARF

TUAN DAM
SUPERVISORY PATENT EXAMINER